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In the

Supreme Court of the United States.

OCTOBER TERM, 1949.

No.

FRANK N. STEIGLEDER,
PETITIONER,
v.
EBERHARD FABER PENCIL COMPANY, ET ALS.,
RESPONDENTS.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable the Chief Justice of the Supreme Court of the United States and the Associate Justices Thereof:

The Petitioner, Frank N. Steigleder, respectfully requests that a Writ of Certiorari may issue to review the judgment of the United States Court of Appeals for the First Circuit in the case of *Steigleder* v. *Eberhard Faber Pencil Company, et als.,* Federal 2nd Advance Sheets decision rendered August 9, 1949, which affirmed the judgment of the District Court, entered on November 19, 1948, reported on Pages 29 to 34, in the record, and at 81 Federal Supplement, 143.

JURISDICTION.

The jurisdiction of this Court is invoked under the Act of February 13, 1925, Chapter 229, Sec. 1 to 43, Statutes 938, U.S. Code, Title 28, Sec. 347.

This petition was filed within ninety days from August 9, 1949, the date of entry of the Judgment of the Court of

Appeals as required by Sec. 8, of the Act of February 13, 1925, *supra* (U.S. Code Title 28, Sec. 350, as amended by Chapter 133, Sec. 2101 (c)).

Notice of the filing of this petition together with a copy of the petition, printed record and supporting brief, have been duly served by the petitioner upon counsel for the respondents and due proof of such service filed with the clerk, as required by Rule 38 of this court.

THE QUESTIONS PRESENTED.

The principal question presented is as to the scope, power, and duty of the Court in acting upon a Motion for Summary Judgment. There is a conflict between the decision of the Court of Appeals, First Circuit, in *Vulcan Corporation* v. *International Shoe Machinery Corporation*, 68 Fed. Sup. 990, affirmed by Per Curiam decision, 158 Federal Second 520, and Ceritorari denied 330 U.S. 825, and the present case which should be set at rest.

The question is important inasmuch as its decision must necessarily affect materially the constitutional right of parties to a full and free trial of all material issues which may be properly brought before a court.

The question is also important in that Rule 56 under which the proceeding for summary judgment is authorized if not liberally construed might well operate to materially impair the rights to a free and fair trial guaranteed by Article 14 of the Amendments of the Constitution of the United States, as well as by Article 5.

Five fundamental questions are involved:

1) Is the party moving for a Summary Judgment under Rule 56 entitled to such judgment as a matter of right in the absence of any agreement or stipulation on the part of the parties as to the material facts involved in the litigation?

2) May the party moving for a summary judgment be entitled to said summary judgment on a showing of facts de-

duced by depositions designed only to develop the theory of the moving party's case and not purporting to develop the facts to support the theory of the opponent's case?

3) In a proceeding for Summary Judgment under Rule 56, may the opponent present affidavits as to a dispute as to material facts before final judgment of the Appellate Court?

4) Is the burden of establishing that there is no dispute as to any material fact upon the proponent of the motion?

5) Is the party opposing the Motion for Summary Judgment obliged at his peril to submit counter affidavits for the purpose of demonstrating that there is a dispute as to material facts?

RULE INVOLVED.

This case calls for an interpretation of Rule 56 of the Federal Rules of Civil Procedure, entitled, Summary Judgment, the pertinent provisions of which are as follows:

(a) *For Claimant.* A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the pleading in answer thereto has been served, move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof.

(b) *For Defending Party.* A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

(c) *Motion and Proceedings thereon.* The motion shall be served at least 10 days before the time specified for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that, except as to the amount of damages, there is no genuine

issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

(d) *Case Not Fully Adjudicated on Motion.* If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court at the hearing of the motion, by examining the pleadings and the evidence before it and by interrogating counsel, shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) *Form of Affidavits; Further Testimony.* Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions or by further affidavits.

(f) *When Affidavits are Unavailable.* Should it appear from the affidavits of a party opposing the motion that he cannot for reasons stated present by affidavit facts essential to justify his opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

(g) *Affidavits Made in Bad Faith.* Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses which the filing of the affidavits caused him to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

This rule is applicable to all actions, including those against the United States or an officer or agency thereof.

STATEMENT OF THE CASE.

This is a patent infringement suit in which the petitioner-appellant is the owner of Patent No. 1,875,184 which he alleges has been infringed by the various respondents-appellees, either by the manufacture or sale of Ball Point Pens embodying the principles patented by the appellant.

The complaint sets forth the patent and alleges in substance that the various respondents have infringed said patent and seeks an accounting and damages.

The answers of the respondents deny the validity of the petitioner's patent and deny that it has been infringed by them if valid.

The respondents filed motion for specifications and in answer thereto the petitioner specified in what respects and as to what articles the respondents were alleged to have infringed his patent. The respondents filed motion to admit facts. The petitioner answered refusing to admit the facts which the respondents now claim entitle them to a summary judgment.

The respondents then took a deposition of the petitioner and relying upon the alleged admissions of the petitioner in answer to the questions propounded in the deposition moved for summary judgment on the ground that as a mat-

ter of law there was no infringement of the petitioner's patent.

Certain pens of the petitioner made according to the patent were introduced into evidence and may be examined by the Court.

No pens of the respondents were introduced into evidence, and no evidence as to the construction of the respondents' pens was introduced, except the statements of the petitioner as to what he had or had not observed of the respondents' pens, made in answer to the questions of respondents' counsel.

There was no stipulation as to agreed facts.

At the hearing on the motion for summary judgment, petitioner presented no opposing affidavits as permitted, but not required under Rule 56, and relied upon argument and statement of counsel only, to show that there was a dispute as to material facts and that summary judgment could not be entered.

After hearing, the District Court entered summary judgment based upon the opinion in the Record, Pages 29-34. On appeal, the Court of Appeals affirmed the judgment by Per Curiam decision. Record, page 39.

STATEMENT OF POINTS RELIED UPON BY THE PLAINTIFF ON APPEAL TO THE CIRCUIT COURT OF APPEALS

(Filed December 17, 1948.)

1. The District Court erred as a matter of law in finding that there are no material facts in dispute, and that there are no genuine and triable issues of fact between the parties hereto.

2. The District Court erred as a matter of law in finding without the aid of expert, extrinsic evidence, that the defendants' pens did not infringe upon the plaintiff's patent.

3. The District Court erred as a matter of law in finding that the defendants did not employ in their pens a substitute or mechanical equivalent of certain of the ingredients set out in plaintiff's patent.

4. The District Court erred as a matter of law in finding that the elements which both the plaintiff's pens and the defendants' pens have in common produce their results by different modes of operation.

5. The District Court erred as a matter of law in finding that the defendants' pens did not contain all of the elements of the plaintiff's pens as set forth in the plaintiff's patent.

6. The District Court erred as a matter of law in finding, by the method of comparison used by said court, that the defendants' pens did not infringe upon the plaintiff's pens.

Respectfully submitted by,

CHARLES E. CUNNINGHAM,
HERBERT S. AVERY,
Attorneys for Plaintiff.

The reasons advanced for the allowance of this petition for a writ of certiorari appear in full in the Brief.

PRAYER FOR WRIT.

Wherefore, your petitioner, by his undersigned counsel, respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals for the First Circuit, commanding that court to send to this court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and also pleadings in the case entitled *Frank N. Steigleder, Plaintiff-Appellant* v. *Eberhard Faber Pencil Company, Defend-*

ants-Appellees, being designated and numbered on its Docket October Term, 1948, No. 4411, and that the said judgment of the Circuit Court of Appeals may be reviewed by this Honorable Court, to the end that your petitioners may have the relief therein prayed for and such other and further relief in the premises as to this Honorable Court may deem just and proper.

Respectfully submitted,

FRANK N. STEIGLEDER,
By his Attorneys,
CHARLES E. CUNNINGHAM,
HERBERT S. AVERY,
112 Water Street, Boston, Mass.

CERTIFICATE.

I hereby certify that Charles E. Cunningham, of Boston, and I, are counsel for the petitioner herein, Frank N. Steigleder; that in accordance with the request of said petitioners the within Petition has been presented; that the allegations contained in said Petition are true, to the best of my knowledge and belief; and that said Petition is, in my opinion, well founded in law and in fact and should be granted.

HERBERT S. AVERY.

COMMONWEALTH OF MASSACHUSETTS

COUNTY OF SUFFOLK, ss. BOSTON, OCTOBER 1949.

Then personally appeared Herbert S. Avery of Boston, Massachusetts, and made oath that he caused the foregoing Petition to be prepared and signed the same and that the same is prepared with the consent of and in accordance with the request of the petitioner named therein and that the

allegations contained in said Petition are true to the best of his knowledge and belief.

Before me,

ELI FLEISHMAN,
Notary Public.

My commission expires August 13, 1951.

BRIEF IN SUPPORT OF PETITION.

In support of the allowance of the Petition, the following is respectfully submitted:

ARGUMENTS AND AUTHORITIES.

I.

THE PARTY OPPOSING THE MOTION FOR SUMMARY JUDGMENT IS IN A FAVORED POSITION, ESPECIALLY IN A PATENT CASE.

Is there *any* basis in the record supporting Petitioner's claim that Respondents infringed his patent? To answer this question negatively, the court must be free of all reasonable doubt. "Pleadings on which motions (for summary judgment) are based, are to be liberally construed in favor of the party opposing the motion." (*Putney Cheeze Company* v. *Frank Ryser Company*, 156 Federal Second 88, referring to Rule 56 (c) FRCP). Again, ". . . . summary judgment on supporting affidavit should not be granted the defendant if the record discloses any basis for a claim in the plaintiff." (*Veatch* v. *Standard Oil Company of California*, 49 Fed. Sup. 45, 134 Fed. 2nd 173—DC.N.Y. 1943—referring to rule 56 (b) of FRCP). It may be pointed out that in the case at bar the defendent filed no affidavits in moving for summary judgment. Therefore, the quotation from the *Veatch* case applies more strongly in favor of the Petitioner here. Next, "on defendant's motion for summary judgment, the court must accept the

allegations of the complaint as true and summary judgment is to be granted against the plaintiff only if the facts (in the record) are insufficient as a matter of law." (*Furton* v. *City of Menasho*, 149 Fed. 2nd 945; cert. denied 66 S.C.R. 176, 326 U.S. 771). And, of course, the "burden that no issue of fact exists is on the party moving for summary judgment." (*Gonzales* v. *Tuttman*, 59 Fed. Sup. 858).

Lastly, we quote from page 50 of the 1947 edition of the Federal Rules of Civil Procedure, "Recent Developments" section:

> "The courts have hesitated in granting summary judgment in patent cases, apparently because the factual situation is usually so complicated that the distinction between formal and genuine issues is not obvious in the absence of all the proof that would be offered at a trial."

In support of this statement *Bliss Company* v. *Cold Metal Process Company* (47 Fed. Sup. 897, D.C., N.D., Ohio 1942) was cited. In that case the court said (page 899):

> "It seems to be the accepted rule that claims covering important inventions will not be struck down by summary judgment where the parties have not agreed on the facts or have not both moved for summary judgment."

(Citing 25 Fed. Sup. 965; 28 Fed. Sup. 813; 44 Fed. Sup. 460). Certainly, in the case at bar the parties have not agreed on the facts and the Petitioner has never moved for summary judgment.

It is interesting to compare here the *Bliss* case (*supra*) with *Vulcan Corporation* v. *International Shoe Machinery Corp.* reported in full in 68 U.S. Pat. Quart. 275 (see also 71 U.S.P.Q. 310, and cert. denied 330 U.S. 825). The *Vulcan* case is the only case cited by the Circuit Court in sustaining the District Court. On the basis of the quotation

from the *Bliss* case above, the *Vulcan* case is easily distinguishable from the case at bar. In the *Vulcan* case drawings of the alleged infringement were admitted by the Plaintiff to be accurate. These drawings were a part of a series of stipulated facts considered by the court in granting summary judgment. The court had before it an admittedly true representation of the allegedly infringing device. In the case at bar, the court had no evidence of the mechanics of the infringing pens, no way to compare the devices in question except the mistakenly construed deposition of Petitioner.

On the basis of the argument above, we submit that the courts below lost sight of the fact that Defendants-Appellees had the burden of proof, and that their pleadings for summary judgment are to be liberally construed *against* them.

II.

THE COURTS BELOW ERRED AS A MATTER OF LAW IN ASSERTING THAT THERE WERE NO ISSUES OF MATERIAL FACT.

Disregarding everything in the record, except Petitioner's deposition, we assert there is a sound basis in the record for Petitioner's claim. We use this part of the record merely because the court used it as the basis for summary judgment. Therefore, if there is *any* basis in this part of the record for Petitioner's claim, the argument of the District Court, which was adopted by the Circuit Court, fails.

> ". . . a litigant has a right to a trial where there is the slightest doubt as to the facts."
>
> *Duehler* v. *United States,* 149 Federal Second 130.

The Court's argument is based on three points:

(a) Petitioner's patent is a combination patent.

(b) Every element enumerated in a combination patent

claim is deemed essential, unless a mechanical equivalent is substituted therefor.

(c) Petitioner's deposition shows that Petitioner clearly admits the lack of essential elements of his patent in the alleged infringements.

Admitting (a) and (b) to be true for the sake of argument, we emphatically deny (c). We assert that the courts completely misconstrued Petitioner's answers in the deposition.

It is important to note again that the only "evidence" considered by the District Court was the deposition. There was no affirmative evidence as to how Defendants' pens operate, nor as to what their mechanical structure is. The Court merely assumed that these pens are made differently and operate differently from the Petitioner's pens.

It should also be noted that the Petitioner had not offered any direct testimony as to the technical grounds on which his claims for infringement were based and that in his deposition, Petitioner specifically reserved his right to offer further testimony (page 27 of record).

> "It is well settled that rule 56 authorizes summary judgment only where the moving party is entitled to judgment as a matter of law, *where it is quite clear what the truth is and that no genuine issue remains for trial.*"
>
> *Perkham* v. *Bonrico et al.*, 171 Federal Second, 653.

Certainly, in the case at bar, it was impossible for the Court to know "what the truth is." It was impossible to say "no genuine issue remains for trial." Plaintiff's evidence was not submitted, and the Court arbitrarily deprived him of his right to submit it in spite of his specific reservation.

> "The purpose of the rule is not to cut litigants off from their right of trial if they really have issues to try."
>
> *Sartor* v. *Arkansas*, 312 U.S. 620.

The Plaintiff's patent covers a writing instrument, the offending articles are writing instruments. Each consists of a Ball Point Device through which liquid is metered upon paper when used as a writing instrument. Except for a difference in the size of the ball point, there is little difference to be observed by the layman between the Plaintiff's pens and the offending pens.

Although not on exhibit, if the Court had before it a specimen of the offending pens, such pens being in almost general use, the Court would observe that when not in use, the fluid does not flow out of the point, but that upon pressure upon the point in a writing position fluid is metered upon the paper, and that this pressure is substantial.

The very fact that no fluid flowed when the pen was not in use and did meter when pressure was applied to the point would demonstrate that there is a longitudinal movement of the ball within the socket sufficient to permit the opening of the valve and the metering of the ink. The District Court in its opinion on Page 33 of the Record, says of the offending pens,

> "Nor does it permit the longitudinal movement of the ball under pressure exerted from the outside so as to create an opening for the flow of ink when the pen is in use."

At the bottom of the same Page 33, the Court said:

> "In the allegedly infringing devices, however, it is admitted that the ball is incapable of any movement except that of rotation *in situ* within the socket in which it is seated. It cannot be displaced so as to cut off the flow of the ink at one time, nor so as to enlarge the opening through which the ink is to flow at another time. The only opening for the feeding of the ink supply, the minute clearance between the ball and its socket, remains constantly the same size. There is no valve

action, *i.e.*, no opening, closing, or obstructing of the passageway for the liquid by any displacement of the ball. The allegedly infringing pens, from the patentee's own admissions, do not utilize the mode of operation found in the patented article, namely, the valve action of a ball held in place by a spring, but must depend on other mechanical principles for control of the ink supply."

It is clear from the foregoing that the Court did not fully understand the Plaintiff's contention with reference to the offending article. The plaintiff did not make the admissions as understood by the Court.

See Record, Page 24.

Q. 20. "In any of the pens which you accuse of infringing your patent, Mr. Steigleder, is there any arrangement for a bodily displacement of the ball with respect to the casing of the pen?"

A. "Only the tolerance or clearance."

Q. 21. "Isn't it true generally speaking, that that is sufficient to permit the ball to rotate in the socket but not to move bodily longitudinally along the pen?"

A. "Yes and no. When you have a ball and socket you have a clearance or tolerance of maybe .002 or .001 of an inch; naturally it will shove back when you put pressure on it so that there is a slight movement. It wouldn't move at all if it were a snug fit."

Q. 22. "The reason for the clearance which you have referred to is to permit the ball to rotate?"

A. "And also to feed the ink."

It will be seen from the foregoing that the plaintiff did not admit that the ball in the infringing devices was "incapable of any movement except rotation *in situ* within the socket in which it is seated," but on the contrary, said that it was capable of longitudinal movement.

It will also be seen that the plaintiff did not admit that the minute clearance between the ball and its socket remained the same size, but that it would shove back when pressure was applied to permit the metering of ink.

The plaintiff did admit that in his patented article a coil spring was called for, placed back of the ball and bearing at its other end upon fingers in a sleeve in the tube and in none of the offending articles that he had examined was there any such spring, but the respondents-appellants have conceded in their brief and argument to the Court of Appeals, and presumably will now concede, that if the spring were replaced by "some other resilient member, such as sponge rubber, a compressible gas, or other means of producing yielding and resilient pressure, then in truth there would be some substance to an argument that an equivalent had been employed."

If an equivalent had been employed, infringement would follow: Page 16, Respondents Brief to Court of Appeals, also Page 11.

Obviously, there is longitudinal movement of the ball in the offending pens sufficient to open the valve when the ball is pressed for writing. Obviously, there is also a sufficient pressure on the ball of the offending pens to close the valve and stop the flow of fluid when the pressure is removed from the point and the pen is not in use.

There was no evidence before the District Court as to what is the equivalent to the spring in the plaintiff's pen that causes the valve in the offending pens to open and close just as does the valve in the plaintiff's pens.

On this issue at least expert evidence was required, and expert evidence if offered would have shown that in fact the opening and closing of the ball valve in the plaintiff's pen with the spring was the same proportionate distance compared to the size of the ball in the plaintiff's pen as was the opening and closing of the valve in the offending pens

as compared to the smaller size of the ball in the offending pens.

Expert testimony further would have shown that the viscous fluid used in the offending pen performed the same function as the spring in the plaintiff's pen in exerting pressure to close the valve and that the metal socket of the offending pens performed the same function as the spring in the plaintiff's pen in supplying the friction necessary to control the rotation of the ball, that in fact there was in the offending pens every element that existed in the plaintiff's pen or a substantial equivalent therefor. (See affidavit of George R. Kent hereto attached.)

In other words, the offending pens did the same work in the same way as the plaintiff's pen.

We are submitting these observations on page 11 of the defendants-appellees' brief to the Court of Appeals. It is admitted that

> "if the defendants had copied from the appellant's structure by substituting a sponge rubber tube in place of a spring called for by the claims, there would be no doubt that the resilient rubber tube would be the equivalent of the claimed spring. This would be so because the operation of the device would then be functionally identical with the operation of the claimed device. That is to say, when pressure was applied upon the ball, the rubber would compress just as the spring does and permit the ball to unseat itself and open a passageway for the flow of fluid. This, however, is not the case. The defendants have provided no means by which the ball can be unseated, no means by which a passage for fluid is opened or closed."

[There was no evidence of this, and the facts are just the opposite.]—And on page 16 of the defendants' brief, they say,

"Thus, we may say that if the spring were replaced by some other resilient member, such as sponge rubber, a compressible gas, or other means of producing yielding and resilient pressure, then in truth there would be some substance to an argument that an equivalent had been employed. But while there is no provision for yielding bodily movement of the ball [this is not the fact], how can it be said that an equivalent to the spring has been employed? In the case of the appellant's pen the bodily movement of the ball opens a passageway through which fluid can flow from the pen casing to the exterior. In the defendants' pen, there is no passageway which is alternately opened and closed by bodily movement of the ball."

[This is not the fact.] (See affidavit of George R. Kent hereto attached.)

It is obvious that the defendants' pen has a valve that is closed when the pen is not in use. Otherwise, the fluid would flow through it continuously, whereas the flow of ink is only at the times when the pen is in use.

It is also obvious that if the ball of the defendants' pen fitted closely into the socket and that there was no room for play between the shoulder and the tip of the pen, there could be no movement of the ball; and if there was a movement of the ball, there would be no room between the ball and the edge of the point through which fluid could pass out of the pen and onto the paper. The rotation of the ball, if it were closely fitted with no opening for fluid to pass, would simply result in removing from the surface of the ball any fluid that might attach while it was in the cavity before it could pass through the space at the end of the pen.

It is obvious, therefore, that in the defendants' pen upon pressing upon the ball a sufficient opening must be made to allow fluid to pass from the cavity at the rear, out of the pen, onto the paper.

It is obvious, also that the size of the ball in the appellant's pen is much larger than the size of the ball in the defendants' pen.

Obviously, therefore, less pressure will be required to close the valve in the defendants' pen than in the appellant's pen.

Adequate pressure to close the valve in the defendants' pen is provided by the pressure of the fluid upon the ball.

Pressure upon the point of the defendants' pen overcomes the pressure of the fluid upon the ball and pushes the ball back against the shoulder, thus permitting the valve to open sufficiently to allow the flow of the fluid. Friction of the ball against the shoulder retards the rotation of the ball and controls the flow of the fluid.

Pressure upon the point of the plaintiff's pen overcomes the pressure of the spring, opens the valve sufficient to allow the flow of the fluid; friction of the ball against the spring retards the rotation of the ball and controls the flow of the fluid. Presence of the fluid is common to both the appellant's and defendants' pen and, of course, is essential to the practical use of each.

The viscous nature of the fluid in the defendants' pen furnishes a sufficient substance when pressing between the ball and the shoulder to provide the required resilience to close the valve when the pen is not in use and to open the valve when pressure is applied for the purpose of writing.

It should be noted that in denying that the socket is the equivalent of a spring, the District Court *made a finding of fact.* By reading Petitioner's answer in the deposition, and without any evidence as to how Defendants' pens are constructed, the court found as a *fact* that there is no mechanical equivalent of Petitioner's spring in Defendants' pens. This conclusion of fact was wrong as a matter of law. When considering a motion for summary judgment, the court's function is to determine whether there are any

facts in dispute and *not* to decide fact issues themselves. *Sarnoff* v. *Craglia,* 165 Federal Second, 166:

> "Upon a motion for summary judgment, it is no part of the Court's function to decide issues of fact, but solely to determine whether there is an issue of fact to be tried."

On reaching the *fact* conclusion, that there is no mechanical equivalent of a spring in Defendants' pens, the court ignored a healthy rule laid down in *James P. Marsh Corporation* v. *U. S. Gauge Company* (CCA. Ill. 1942-129 Fed. 2nd 161):

> " 'Mechanical equivalents' is a relative term and is elastic to catch the evil practitioner who copies the thought and omits only the unessential features."

The other cases cited by the District Court to bolster its assertion that "in a combination patent every element or ingredient is presumed to be material . . ." etc. have qualifications which the District Court ignored. For example, *Etten* v. *Kauffman* (CCA 2 1941-121 Fed. 2nd 137) says each ingredient is presumed material *but* page 140:

> "The rule has been stated on a number of times, and always to the same effect, *except for the qualifications* that the addition of an equivalent for the omitted element will not avoid infringement . . ."

Now, in our case, a question of fact is, is there an equivalent for the spring? *Band Atlas* v. *McAneny* (CCA 10-1942, 131 Fed. 2nd 766) also cited by the District Court also has the same qualification

> ". . . unless a mechanical equivalent is substituted therefor."

In declaring (page 33 of record) "there can be no infringement when the allegedly infringing device does not

have substantially the same mode of operation as the patented device" the District Court cited *Aero Spark Plug* Co. v. *B. G. Corp.* (130 Fed. 2nd 240). In that case, the patented device provided for a "fill-in" to exclude all air from the interior of a spark plug while the allegedly infringing device had an air-tight block to prevent air from either getting in or out. Obviously, the court must have seen some analogy between the spring on the one hand and the "fill-in" on the other; between the shoulder plus the fluid on the one hand, and the "Block" on the other. This is not true. The shoulder exerts pressure on the turning motion of the ball, just as the spring does. The fluid exerts a hydraulic pressure on the ball to prevent the fluid from leaking when the pen is not in use; just as the spring does. Pressure on paper overcomes the pressure of the spring. Pressure on paper overcomes the hydraulic pressure of the fluid. This analogy is perfect. The *Aero* case is completely different.

The other case cited by the court to show that the two devices have substantially different modes of operation is *Grant* v. *Koppl* (99 Fed. 2nd 106). There is nothing in this case germane to the issue unless it be the statement that the range of equivalents should be narrow when a prior art is copied to a great extent. Now, to what extent the shoulder plus the fluid is equivalent to the spring is a question of fact to be determined by a comparison of the two pens in issue, not by a misconstruction of the Petitioner's deposition.

We submit that our case is more like *Union Paper Bag Machine Company etal* v. *Merrick Murphy et al* (97 U.S. 120, 24 L. Ed. 935) than the *Aero Spark Plug* case. In the *Machine Company* case, the court said:

> "the substantial equivalent of a thing in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work, in substantially the same way, and accomplish substantially the same re-

sult, they are the same, even though they differ in name, *form* or *shape.*"

Defendants make a great deal out of the alleged fact that the sleeves in the infringing pens do not contain inwardly turned fingers. Admitting this as true, is it not merely a matter of form and/or shape? Indeed, the shoulder in Defendants' pen is the same in shape, in function, and proportionally in size.

Continuing with the *Machine Company* case, the patented device was a paper cutting machine which, in one operation cut paper so that it could immediately be folded into bags. Knives fell on the paper as it rolled on a table beneath. The device which was held to be an infringement, provided for stationery knives beneath the rolling paper. The knives came in contact with the paper when a heavy piece of metal was allowed to press down on the paper. If the rising and falling metal plus the stationery knives are equivalent to the falling knives, then the shoulder plus the pressure of the fluid are equivalent to the spring. The shoulder corresponds to the stationery knives; the falling metal corresponds to the weight of the fluid.

Next, it is extremely important that the depositions not be abused.

> "Pleadings on which motions (for summary judgment) are based, are to be liberally construed in favor of the party opposing the motion."
>
> *Putney Cheeze Co.* v. *Frank Ryser Co.*, 156 Federal Second 88.

A reading of the questions put by defendants' attorney in the deposition clearly shows that he was trying to develop his theory of defense. They indicate that he was trying to develop a theory that defendants' pens are not the mechanical equivalent of petitioner's. These questions were excellently designed, and without doubt, carefully drafted for

this purpose. It was his skillful questioning rather than any facts developed therefrom, which caused the learned courts below to err. Suppose question 13 of the deposition (page 23) had read: "In any of those pens is there a spring of any sort, *or a mechanical equivalent,* which bears against the ball"; instead of "is there a spring of any sort which bears against the ball?" Suppose Question 25 (page 25 of record) had been "In any pen which you accuse of infringing your patent, is there any sleeve, or *its equivalent,* which bear against any spring or *its equivalent?*" Yes, if these questions had been asked as indicated, *facts,* disagreements, contentions, and *issues* would have been developed clearly. But this was not the object of the learned attorney for the defendants. It was his object to make it appear, as far as possible, that there was no issue of fact, without evidence of any value to that effect.

One of the main purposes of the Rules is to do away with tricky pleading and old-fashioned formalism which prevented many cases in the past from being decided on their merits. Could it be that this condemned procedure is being brought in by the back door under the Rules (26 and 36) covering depositions? Is it not time to reexamine the broad scope of these rules and to put reasonable restriction on their use? Is a person, like Steigleder, the petitioner, to be penalized because his use of language is not precise, because he does not understand patent law terms such as "mechanical equivalent?" Are we to return to a barbarous formalism and assert that a just cause must be lost because a man simply says, "there are no springs," without adding a legalistic phrase such as "but I solemnly swear, affirm, and assert that there is a mechanical equivalent thereof?"

This, we are sure, is a situation which this Honorable Court will not permit to continue.

Again, we do not admit that the patent in issue is a combination patent, of the usual type. The device is not

merely a combination of old materials in a new way; it is a combination of old materials plus new elements. The question is not merely whether the infringing device omits an element of the patented device and thus escapes the charge of infringement, nor whether the infringing device substitutes a mechanical equivalent, and thus fails to escape the charge of infringement. The question is: does the infringing device copy the new feature of the patented device? In their answer to the complaint (page 18 of record, answers 4 and 5) the Defendants deny that petitioner was "the original and first inventor or discoverer of any material or substantial part of the thing or things patented in Patent No. 1,875,184" and assert that petitioner infringed certain other patents set out on pages 19-20 of the record. These statements in the answers in effect deny petitioner's assertion in the Bill of Particulars that defendants infringed, among other things:

"1. In the use of a ball point for the spreading of the liquid." (Page 17 record.)

Also, by answer 3 (page 18 of record) they again deny the same thing.

These denials raise two issues of fact:

1. Do defendants' pens infringe in the use of a ball point, among other things?

2. Does petitioner's patent itself infringe other patents?

In passing, it may be pointed out that the Supreme Court has held that it is the better practice to inquire into the validity of the patent in suit before considering the question of infringement. The issues framed above could have allowed this procedure approved by the Supreme Court.

The District Court in making the bold statement that "in a combination patent every element or ingredient is presumed material" cited *Prouty* v. *Ruggles*, 16 Peters, 336 at 341. Here are the important remarks made on 341 of that case (emphasis ours):

> "The patent is for a combination, and the improvement consists in arranging different portions of the plan, and combining them together in the manner stated in the specifications for the purpose of producing a certain effect. None of these *parts referred to are new*, and *none are claimed as new; nor is any portion of the combination less than the whole claimed as new*, or stated to produce any given result. . . . The use of any two of these parts only, or of two combined with a third, *which is substantially different* in form or in the manner of its arrangement and connection with the others is therefore not the thing patented. It is not the same combination if it substantially differs from it in any of its parts."

This is not the same as the case at bar. The Steigleder pen is not merely a re-arrangement of old elements as was true of the plow in question in the *Prouty* case, but also incorporates new elements.

Finally, we submit that petitioner was deprived of his constitutional right to a full and fair trial. As pointed out above, the trial judge made repeated findings of fact, in complete violation of Federal Rule 56, because of misinterpretation of facts which required expert testimony (see *Bischoff* v. *Wethered*, 9 Wal. 812, 814):

> "It is undoubtedly the common practice of the United States Circuit Courts. . . . to take the evidence of experts as to the nature of various mechanisms . . . described in the different patents produced, and as to the identity or diversity between them. . . . We are disposed to think that the practice adopted by our Courts is . . . the safest and most conducive to justice."

Again, petitioner was deprived of the very right to introduce evidence. Petitioner reserved the right to offer further testimony when the deposition was taken. This right

was never exercised because the summary judgment intervened. In his oral argument against summary judgment before the District Court, counsel for the petitioner repeatedly asserted that expert testimony would be available at trial to show the existence of issues. Petitioner was not required to produce the expert testimony then and there. He was not required to file an affidavit under Rule 56. The rule is merely permissive.

In the *Vulcan* case and the other cases referred to above, the Court either had evidence from both sides, or agreed facts on which to grant summary judgment. Here, there were no stipulations, no agreed facts, and no evidence from either side. The only basis for summary judgment was petitioner's misconstrued statements. The Court cavalierly disregarded the probable effect of petitioner's evidence.

This situation, too, we are sure will not be allowed to continue by this Honorable Court.

Attached hereto is an affidavit by George R. Kent, a duly qualified expert.

CONCLUSION.

Your petitioner respectfully submits, therefore, that this Honorable Court should grant Certiorari in this case.

Respectfully submitted,

CHARLES E. CUNNINGHAM,
HERBERT S. AVERY,
Solicitors for Appellant.

AFFIDAVIT of GEORGE R. KENT.

Re: Frank N. Steigleder v. *Eberhard Faber Pencil Company, et als.*

I, George R. Kent, solemnly swear that I have the following qualifications: I have worked in various phases of engineering since 1925; I received a Bachelor of Science degree in Civil Engineering from The Cooper Union Night School of Engineering, an institution recognized by the Board of Regents, State of New York, in 1940; I am a member of the Massachusetts Society of Professional Engineers, and I am a Licensed Professional Engineer of the State of New York; I am now employed by Stone & Webster Engineering Corporation, Boston, Massachusetts, in their Process Division.

I also solemnly swear, that the construction and operation of a pen is so elementary that its function is fundamental to all fields of engineering.

I, George R. Kent, also solemnly swear (or affirm) after a careful examination of the Steigleder patented device (No. 1,875,184) and the Eversharp large ball point pen, licensed to the Eversharp Company by Eberhard Faber Pencil Company, that the two mechanisms are identical in many respects and are mechanical equivalents in all other respects, for reasons which will be set out below.

First, an explanation of the drawing submitted herewith is necessary. It is impossible to examine the mechanism of the infringing device without first magnifying it. For this purpose a photomicrograph was taken. This merely magnified the parts of the infringing device, keeping each part in proper proportion to each of the others. Figure 1 is a cross section view of the infringing pen, in correct proportions, to the photomicrograph. Figure 1 represents the infringing device magnified 20 times. Figure II represents the Steigleder device *magnified ten times.*

My reasons for the conclusions stated above are:

1. The housing (Fig. I and II) was made to contain the completed assembly which is duplicated in all of the pens in question.

2. The ball point provides the means for metering out the fluid on paper, an item identical in both pens. (All Figures)

3. The spun tip, in both pens, prevents the ball from falling out when the pen is not in use.

4. In the infringing pen (Fig. I) the spun tip plus the hydraulic pressure of the fluid against the ball, seals the ink within the pen when it is not in use. This is mechanically equivalent to the spring plus the spun tip in the patented device (Fig. II). Fluid is a common substitute for a spring, well known to those skilled in mechanical arts. Hydraulically operated brakes on automobiles, and hydraulically operated elevators are two of the most common devices used in this way. Liquid pressure and spring pressure are closely, narrowly equivalent. When the ink supply in the infringing device is low, it frequently has a tendency to leak because the springlike hydraulic pressure on the ball is not sufficient to prevent it from moving back, longitudinally, from the spun tip to the shoulder (Fig. I). This defect corresponds exactly to the defect in a hydraulic break, for example, when the fluid becomes low for some reason. Then, the spring-like action of the fluid, when the break is pressed, is not sufficient to stop the vehicle.

5. A recessed pocket and three ditches (Fig. I) are provided to keep the inner surface of the ball in a wet state precisely as the open sleeve in the Steigleder pen (Fig. II). The pocket and the ditches are mere changes in shape and form, mainly to compensate for the less efficient shoulder. When the ink supply is low, the fluid tends to concentrate in the ditch and/or recess. This concentration of the fluid in a small area, obviously, concentrates the spring-like hy-

draulic pressure on a part of the ball thus closing it against the spun tip more tightly, and thus overcoming the leaking tendency at least in part. The recess and ditches are also necessary, as indicated above, as equivalents of the open sleeve (II) to have the inner part of the ball exposed to fluid at all times.

6. The shoulder (Fig. I) which is made up of three segments, is to prevent the ball from being pushed back into the barrel of the housing, beyond the limit of the clearance, and is identical with the three inwardly directed fingers (See patent), or expansion ring, in plaintiff's pen, in shape, and proportionally, in size, and also in function.

7. The clearance, (Fig. I) permits freedom of movement for the ball and corresponds to the flexibility of the plaintiff's spring (Fig. II).

8. The narrow channel restricts the ink when the ball is pressed upon it in the act of writing. The restriction causes the retarded ink to act as a hydraulic shock absorber in precisely the same manner as the plaintiff's spring.

9. In Figures I the grip, measured on the circumference when the spun tip is tangent to the ball, is the same, proportionally, as the corresponding grip on plaintiff's pen (Fig. II). In other words, the ball is seated in exactly the same way in both pens. Proportionally, the same areas are exposed or hidden from view in both devices at all times. The efficiency of the ball depends upon what proportion of the ball is exposed. It is my opinion that this efficient proportion can be found only after careful experimentation.

I do solemnly swear that each and every one of the above nine statements are true to the best of my knowledge and belief.

I further solemnly swear that, as an expert, it is clear to me that the defendant's pen is actually a duplication of the plaintiff's patent in all its essential details.

GEORGE R. KENT.

COMMONWEALTH OF MASSACHUSETTS

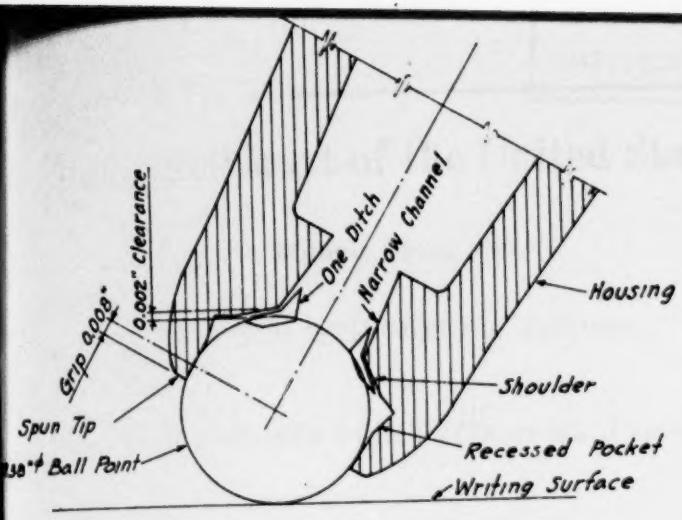
SUFFOLK, ss. Boston, September 23, 1949

Then personally appeared George R. Kent of Newton, Massachusetts, and made oath that he caused the foregoing affidavit to be prepared and signed the same and that the allegations contained in said affidavit are true to the best of his knowledge and belief.

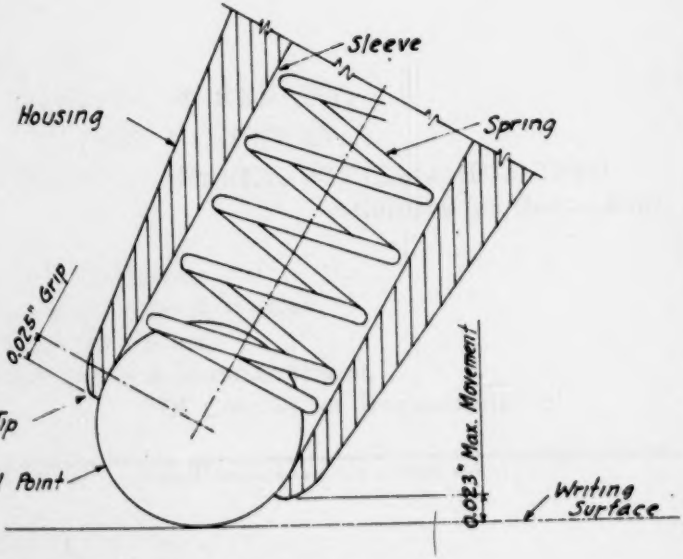
Before me,

ELI FLEISHMAN,
Notary Public.

My commission expires August 13, 1952.



SECTION THROUGH TYPICAL DEFENDANTS PEN
ENLARGED 20X
FIG. I



SECTION THROUGH STEIGLEDERS PEN
ENLARGED 10X
FIG. II